

Serial No. 10/828,977

Filed: April 21, 2004

Amendment and Response to Office Action mailed July 18, 2007

Filed on September 18, 2007

REMARKS

Claims 5-13, 18-30, and 32-38 are pending in the present application. Claims 14-17 and 31 have been canceled without prejudice or disclaimer of the subject matter therein, pursuant to 37 CFR §1.116 in order to reduce issues for appeal. Reconsideration and allowance of pending Claims 33-38 is respectfully requested in view of the following remarks.

Allowed Claims

Applicant thanks the Examiner for the indication that Claims 5-13, 18-30 and 32 are allowed.

The 35 U.S.C. §112 second paragraph Claim Rejections

Claims 14-17 and 31 were rejected pursuant to 35 U.S.C. §112 second paragraph as being indefinite. Claims 14-17 and 31 were canceled rendering these rejections moot.

The 35 U.S.C. §102(e) Claim Rejections

Claims 33 and 36-38 were rejected pursuant to 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,594,242 to Kransmo (hereinafter referred to as "Kransmo"). In addition, 14-17 and 34-35 were rejected in view of the combination of Kransmo and U.S. Patent No. 6,697,620 to Lamb et al. (hereinafter referred to as "Lamb"). Finally, Claim 31 was rejected pursuant to 35 U.S.C. §103(a) as being obvious in view of the combination of Kransmo, Lamb and what is well known in the art. Claims 14-17 and 31 have been canceled rendering these rejections moot. With regard to Claims 33-38, Applicant respectfully traverses these rejections because all of the limitations described in Claims 33-38 are not taught, suggested, or disclosed by the cited prior art, either alone or in combination.

For example, the method of Claim 33 describes said mobile terminal sensing a change in location of said mobile terminal, and said mobile terminal, responsive to said change in location, checking said registration possibility information to confirm registration to said first mobile communication network is available. On page 3 of the office action mailed July 18, 2007, it was asserted that Kransmo's description that the "MS takes measurements of the carrier channels such

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as signal strength" is equivalent to these limitations. Applicant respectfully traverses these assertions since Kransmo is completely unconcerned with a mobile terminal sensing a change in location of said mobile terminal, and thus neither expressly nor inherently describes such limitations. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In addition, a reference must describe a claimed invention sufficiently to place the claimed invention in the possession of one of skill in the art in the field of the invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000). Clearly, measurement of signal strength as described by Kransmo, and a mobile terminal sensing a change in location of said mobile terminal are wholly unrelated functionality.

Claim 33 also describes responsive to said change in location, checking said registration possibility information to confirm registration to said first mobile communication network is available. Kransmo, on the other hand, describes measuring and ranking signal strength to determine which channel to transfer to. Even if there is correspondence between registration possibility information and signal strength as asserted on page 3 of the office action mailed July 18, 2007, Kransmo clearly describes that such signal strength measurements are on-going and have no correlation with a change in location of a mobile terminal. Thus, contrary to the assertions on page 3 of the office action mailed July 18, 2007, Kransmo fails to teach or suggest anything that is responsive to a change in location of a mobile terminal, and quite clearly does not describe responsive to a change in location of a mobile terminal, checking registration possibility information to confirm registration to said first mobile communication network is available.

Claim 34 describes said mobile terminal transmitting a notification message to a management device in communication with both said first mobile communication network and said second mobile communication network, said notification message indicative that registration has been successfully changed to said first mobile communication network. On page 10 of the office action mailed July 18, 2007, it was asserted that Lamb describes such limitations. Applicant respectfully traverses these assertions since Lamb clearly describes a request for registration communicated between a mobile phone and a Mobile Switching Center (MSC), and separate, and entirely different, communication between the MSC and a Universal Location Service Register (ULSR). (Col. 6 lines 23-50) In addition, Lamb describes that the ULSR determines whether a mobile phone can be registered to a network, and if so, updates a database

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with the current registration. (Col. 5 lines 1-6) In sharp contrast, Claim 34 describes that it is a mobile terminal that transmits a notification message indicative that registration has been successfully changed. Thus, Lamb not only fails to teach or suggest such a notification message from a mobile terminal, but actually teaches away from such functionality by describing a registration determination that is performed by a ULSR, while a mobile phone simply requests registration and awaits the ULSR determination. Not only is Lamb's ULSR not receiving anything from a mobile terminal and is instead receiving information only from an MSC, but also it is Lamb's ULSR that is making a registration determination and providing an authorization message for such a registration. (Col. 5 lines 4-6) Thus, the combination of Kransmo and Lamb fail to teach or suggest each and every limitation described in Claim 34.

Claim 35 describes transmitting a mobile terminal identifier and location information of said mobile terminal to said location management device, and transmitting a notification message comprises transmitting a terminal identifier of said mobile terminal and a control code to activate said first mobile communication network. On page 12 of the office action, it was apparently asserted that Lamb described such limitations, however, the cited portions of Lamb are wholly unconcerned with and completely silent regarding transmittal of either location information of a mobile terminal or a control code to activate a mobile communication network. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the instant case, limitations present in Claim 35 are entirely absent from both Kransmo and Lamb, and assertions that such limitations are expressed or implied in the cited portions of Kransmo and/or Lamb are completely unsupported with a convincing line of reasoning.

Claim 37 describes that receiving, with said mobile terminal over said second mobile communication network, registration possibility information comprises storing said registration possibility information in a memory included in said mobile terminal, and checking said registration possibility information comprises accessing said stored registration possibility information in said memory. On page 4 of the office action mailed July 18, 2007, it was asserted that Kransmo described such limitations, however, the cited portions of Kransmo fail to describe a

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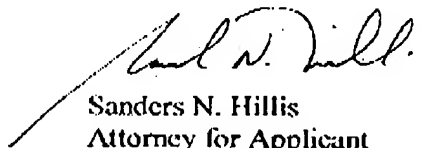
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memory, or storage of anything in memory. Thus, Kransmo does not describe storing registration possibility information in a memory. If the Office Action intended to assert that Kransmo's "measurements of the carrier channels, such as signal strength" inherently includes storing registration possibility information in a memory, the burden of proof for inherency must be met. Specifically, in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP §2112 (citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). In the instant case, not only has inherency not even been specifically postulated, but also no such basis in fact that alleged inherent characteristics necessarily flow from the teaching of Kransmo has been provided.

For at least the foregoing reasons, all of the limitations described in Claims 33-38 are not taught or suggested by the cited prior art, either alone or in combination. Thus, a *prima facie* case of obviousness has not been established and cannot be maintained. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(e) and the 35 U.S.C. §103(a) rejections of Claims 33-38.

With this amendment and response, all of the presently pending claims of this application are allowable, and Applicant respectfully requests the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,


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